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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,834	06/20/2001	Peter Beckmann	MO-6412/WW-5	6293

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BAYER CHEMICALS CORPORATION
PATENT DEPARTMENT
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PITTSBURGH, PA 15205-9741

EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,834

Applicant(s)

BECKMANN ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Response to Amendment

The 112 and 103 rejections are withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,284,688 to Hiatt in view of USPN 6,221,191 to Davis et al. and USPN 4,686,260 to Lindemann.
2. Hiatt teaches a pressure sensitive adhesive label having a film carrier (2) of biaxially oriented polypropylene suitable for packaging applications at col. 4, lines 25-30 and lines 55-65, and col. 5, lines 1-6 comprising an heat-sealable lacquer applied by screen printing of EVA at col. 6, lines 30-45. The film has ink-free sealing area in Figure 1, see the area between the spaced apart strips 8, 10, and 12, providing an ink-free area (further meeting claim 11). See also col. 5, lines 60-68. The film is made peelable by the fact it can be wound on itself to form a roll-type package so that the pressure-sensitive adhesive faces outwardly and engaged by the weak release surface of the carrier (equivalent to a BOPP film having peelable sealing properties). Hiatt explains the lacquer is weakly sealable at col. 8, lines 39-45.

Regarding claims 7, 9, and 14, the limitation "is applied...", is a process limitation. The process does not change the product. Product-by-process claims are not limited to the

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manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Hiatt does not state the BOPP film is coextruded (claim 1) or that the surface has an electrically pretreated side as in claim 10). Davis teaches a polyester containing biaxially-oriented polypropylene (BOPP) films that are coextruded for use in packaging and the method of making them. See col. 1, lines 19-30. See col. 3, lines 60-68 teaching coextruding the BOPP layers in the film. Davis teaches coextruded biaxially-oriented films that are treated by corona discharge (inherently providing an electrically pretreated side-claim 10) provide an excellent surface for metallizing, printing, and laminating, see col. 16, lines 50-63, col. 1, lines 25-30, and col. 2, lines 43-55. Hence it would have been obvious to one of ordinary skill in the art to modify the label of Hiatt to modify the BOPP film into a coextruded BOPP film for the purpose of providing a multilayered BOPP film as taught by Davis at col. 3, line 60-col. 4, line 10. Also, it would have been obvious to one of ordinary skill in the art to modify the BOPP film of Hiatt to include an electrically pretreated side since Davis teaches doing so provides an excellent surface for metallizing, printing, and laminating, see col. 16, lines 50-63, col. 1, lines 25-30, and col. 2, lines 43-55. Further regarding claim 10, the limitation "is printed on...by means of..." is a process limitation in a product claim. The process notwithstanding. See MPEP 2113.

Regarding claims 2 and 13, to the addition of PVB, Hiatt does not teach. Lindemann teaches printing ink compositions of EVA and PVB for high gloss lacquers at col. 3, lines 60-68 and col. 4, lines 15-65, while the thermoplastic ink composition may be used in other forms such

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as a film or combined with other resins. It would have been obvious to one of ordinary skill in the art to modify the label of Hiatt to include a lacquer of EVA and/or PVB because Lindemann teaches printing ink compositions of EVA and PVB at col. 2, lines 54-55, col. 3, lines 60-68, and col. 4, lines 15-65 is conventional to provide gloss for printing inks.

Regarding claims 4-5 and 13, the limitation "is applied...", is a process limitation. The process does not change the product. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Regarding claim 11, the limitation "is in the form of..." is a process limitation in a product claim and not patentable. The process does not change the product. See MPEP 2113.

Regarding claim 6, Matsumoto teaches the inclusion of saponified EVA copolymer as a type of EVA to mix with to polyolefins (inclusive of polypropylene), proving polymer compatibility exhibiting enhanced properties such as processability and thermal adhesive properties. See col. 1, lines 5-48 and Table VI. It would have been obvious to one of ordinary skill in the art to modify the label of Hiatt to further include a saponified EVA polymer since Matsumoto teaches the polymer is compatible with polyolefins in order to improve adhesion and processability as taught by Matsumoto as cited above.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

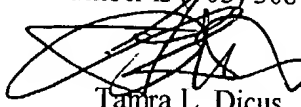
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,830,927 to Vanderhoff et al. Vanderhoff teaches printing ink compositions and methods of making the same where Vanderhoff explains printing ink compositions are printed over polyolefin films for packaging applications using Joncryl 850 as an overprint lacquer. Vanderhoff further teaches generally plastic films are treated with corona discharge to form surface functional groups that enhance the adhesion of inks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Tamra L. Dicus
Examiner
Art Unit 1774

6/25/04

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

